

REMARKS

Applicants present this Amendment and respectfully request reconsideration followed by allowance.

Claims 2, 3, 5, 6, 9, 10, 15-17, 20-23 and 29 are presented for examination.

Claims 7, 8, 11-14, 18, 19 and 24-28 have been canceled without prejudice to reduce the number of claims presented..

Claims 2 and 5 have been amended to define R₃ and R₄ as methyl.

The name of the second compound in claim 29 has been corrected per the specification at page 14, line 5.

Applicants respectfully request the Examiner to enter their Amendment. The canceled claims obviate (e.g. moot) rejections to reduce the issues to be considered. Amended claim 29 overcomes the formality objection and the enablement rejection, both of which were predicated on an editorial oversight in the last paper. Any inconvenience to the Examiner is regretted. MPEP §714.12 ("amendments complying with objections or requirements as to form are to be permitted after final ..."). Defining R₃ and R₄ as methyl in claims 2 and 5 is consistent with the specification disclosure and serves to overcome the remaining prior art rejection(s). The number of claims presented is therefore reduced, The issues to consider are reduced in number. Applicants earnestly solicit entry of the Amendment.

The amended claims find basis in the specification throughout, including the original claims. The Examiner may wish to consider page 6, lines 13-10, page 10, lines 8-14, page 11, lines 1-2, and pages 14-14.

Applicants submit their claims define novel, unobvious inventions over the presently applied art.

The Examiner "bears the initial burden, on review of the prior art . . . , of presenting a *prima facie* case of unpatentability." In re Oetiker, 977 F.2d 1443, 1445 (Fed. Cir. 1992). A rejection cannot be predicated on the mere identification of individual components of claimed limitations. There must be evidence that "a skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." In re Rouffet, 149 F.3d 1350, 1357 (Fed. Cir. 1998); see also In re Werner Kotzab, 217 F.3d 1365, 1371 (Fed. Cir. 2000). "[I]t is incumbent upon the examiner to identify some suggestion to combine the references or make the modification." Ex parte Askman, Appeal No. 96-1548 (June 10, 1999) at page 5, quoting In re Mayne, 104 F.3d 1339, 1342 (Fed. Cir. 1997).

Applicants respectfully traverse the rejection over the combination of JP 46-27874 in view of Ishii '744, JP-06-93070 or JP 57-108154.

First, the primary reference to Ishii '744 does not teach a combination of an amide compound of Applicants' formula (I) in combination with a hindered phenol defined by formula (II) or formula (III). Second, the prior Office Action states that the "primary reference is silent regarding the use of hindered phenol compounds." Prior Office Action, page 4.¹ Third, even if, *arguendo*, the combination of references would have been made, the JP-57-108154 reference ("JP '154") none-the-less is silent regarding the hindered phenol compound and the amide compound. Consequently, it is respectfully submitted that there would have been no teaching to select the amide in particular, select the hindered phenol, and even make the combination as proposed in the Office Action.

¹ See, e.g., Ex parte Browne, 19 USPQ2d 1609, 1612 (BOPI 1990) ("since the prior art is silent as to this feature, we are unable to sustain the rejection which we originally precipitated.").

More particularly, Applicants respectfully request that the rejection over the combination of JP 46-27874 in view of Ishii (JP '744) be reconsidered and withdrawn.

First, the prior Office Action states that the "primary reference is silent regarding the use of hindered phenol compounds." Prior Office Action, page 4. Second, the Ishii '744 reference does not disclose the amide compound. Even if, *arguendo*, the combination of references would have been made, the fact remains that the JP '874 is silent regarding the hindered phenol compound and its combination with a selection of one of the several ingredients from the Ishii '744 reference is in hindsight. It's an hindsight-informed picking and choosing only that which would support the rejection.

Applicants respectfully request that the rejection over the combination of JP 46-27874 in view of JP 06-93070 be reconsidered and withdrawn.

First, as stated above, the primary reference does not teach a combination of an amide compound of Applicants' formula (I) in combination with a hindered phenol defined by formula (II) or formula (III).

Second, the JP '070A reference discloses t-butyl groups at the ortho positions of the phenol moiety. The Examiner is respectfully directed to the Abstract. These structurally different groups would not have suggested the present compounds, nor motivated a person of ordinary skill in the art to undertake the molecular modifications necessary to arrive at Applicants' compounds.

Third, the secondary reference - the English language abstract - apparently refers to a single species of a phenol like compound. It does not appear to describe nor would it have suggested, for instance, a hindered phenol compound of formula (III) in which n is 1, 2 and/or 3, or in which Y has 2 or more carbon atoms. (*See*, specification, page 7, lines 6-14).

Fourth, the secondary reference appears to refer to a molded product obtained by first making a mixture of specific polyisocyanate compound - a preliminary polymer according to the Abstract - and a specific oxidation stabilizer which is later combined with the polyurethane to obtain a molded product said to be "stable in modification moldability and excellent in heat resistance..." The secondary reference - its English Abstract - discloses nothing about combining the specific oxidation stabilizer with any other ingredient to make a color-fast product or to produce a product from which the stabilizers confer resistance against yellowing in nitrogen oxide environments or to produce a product from which the stabilizers will not leach or have reduced propensity to leach. Retroactively searching for one element in a reference - whether it is mentioned in either the primary or the secondary reference, is hindsight, and would not have suggested isolating one feature from a reference and combining it with other ingredients not disclosed in the other of the two references to arrive at the present claimed invention.

Applicants respectfully request the Examiner to reconsider the obviousness rejection of claims 2, 3 and 5-28 over JP-46-27874 in view of JP-57-108154. A

As stated above, the primary reference has no apparent disclosure regarding phenol antioxidants, and would not have taught Applicants' combination of an antioxidants in combination with an amide compound.

The other reference (JP '154) is divergent too as it apparently refers to a 2,2'-methylene bis(4-alkyl-6-*t*-butyl phenol), which is structurally distinct from the hindered phenol antioxidants in claims 2, 3, 5, 6, 9, 10, 15-17, 20-23 or 29. In view of the structural dissimilarity, a person of ordinary skill in the art would not have been motivated to amend the synthesis route for the compounds of JP '154A to make the structurally dissimilar hindered phenol antioxidants in the present invention.

The Examiner apparently also opines that the ingredients that may be incorporated in the present composition would have been obvious based on alleged general knowledge in the art or because individually the ingredients may be known.² The alleged general knowledge would not have provided any direction to the ingredients herein, nor to their being compounded in a polyurethane to obtain a polymer composition from which such ingredients would not be expected to leach or would confer upon the composition satisfactory resistance against yellowing in an atmosphere containing oxides of nitrogen. It is respectfully noted that the Federal Circuit reversed rejections in In re Deul 34 USPQ (BNA) 1210 (Fed. Cir. 1995):

Thus, even if, as the examiner stated, the existence of general cloning techniques, coupled with knowledge of a protein's structure, might have provided motivation to prepare a cDNA or made it obvious to prepare a cDNA, that does not necessarily make obvious a particular claimed cDNA. "Obvious to try" has long been held not to constitute obviousness. In re O'Farrell , 853 F.2d 894, 903, 7 USPQ2d 1673, 1680-81 (Fed. Cir. 1988). A general incentive does not make obvious a particular result, nor does the existence of techniques by which those efforts can be carried out. Thus, Maniatis's teachings, even in combination with Bohlen, fail to suggest the claimed invention.

Similarly, here it is respectfully suggested that the unusually broad over-generalizations asserted in the present Office Action would not have made obvious the particular results obtained by Applicants, nor do they focus on the problem addressed and solved by Applicants.

² Identifying individual elements of an invention is various items of prior art does not establish a *prima facie* case.

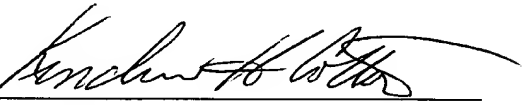
Appln. No. 09/529,717
Amdt. dated September 9, 2004
Reply to Office Action of March 15, 2004

If the Examiner has any questions, please contact the undersigned.

Meanwhile, Applicants earnestly but respectfully submit that their application is now in condition for allowance.

Respectfully submitted,

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